

DOCKET NO.: **BA-0331

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Confirmation No.: **3893**

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Richard A. Pineau**

Serial No.: **10/023,245**

Group Art Unit: 2153

Filing Date: **December 18, 2001**

Examiner: **Yasin M. Barqadle**

For: **METHOD AND SYSTEM FOR GENERATING A PERMANENT RECORD
OF A SERVICE AT A REMOTE PRINTER**

Mail Stop Appeal-Brief Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPEAL BRIEF PURSUANT TO 37 C.F.R. § 41.37

This brief is being filed in support of Appellants' appeal from the final rejections of claims 1-24 dated July 11, 2007 (FR). A Notice of Appeal was filed on December 11, 2007.

1. REAL PARTY IN INTEREST

The real party in interest is Senshin Capital, LLC, a limited liability company of the state of Delaware, with a registered address of 2711 Centerville Road, Suite 400, Wilmington, Delaware 19808 USA and principal office at Temasek Boulevard, #44-01 Suntec Tower One, Singapore 038987.

2. RELATED APPEALS AND INTERFERENCES

None.

3. STATUS OF CLAIMS

Pending	:	Claims 1-24
Cancelled	:	Claims 25-30
Allowed	:	None
Objected to	:	None
Appealed	:	Claims 1-24

4. STATUS OF AMENDMENTS

An amendment was filed after final rejection on October 8, 2007. The Advisory Action entered October 30, 2007, states that the amendment was not entered. However, a handwritten notation on the IFW copy of the amendment states "ENTER" followed by the initials "yb," believed to be the Examiner's initials. In a subsequent telephone conversation with the Examiner on December 11, 2007, the Examiner stated that it was his intention to enter the amendment and that the Advisory Action was in error. Thus, it is understood that the amendment was entered.

5. SUMMARY OF CLAIMED SUBJECT MATTER¹

Under the provisions of 37 CFR 41.37(c)(1)(v), the following summary of claimed subject matter is made. The summary is in accordance with the rule since the rule does not require any particular format for this section of the Appeal Brief. Note also that the commentary to the rules provides “[a]ppellant may include any other information of record which will aid the Board in considering the subject matter of each independent claim.” 69 FR 49976, Comment 53, third column, August 12, 2004.

The Board should note that written descriptive support for the claimed subject matter can be found throughout the specification and figures. A concise summary of the claimed subject can be had by review of the embodiment regarding the providing of tickets that is discussed in paragraphs [0052]-[0055]. Of course to gain a full understanding of the claimed technology the entire disclosure should be reviewed.

Claim 1

Claim Element	Specification Cites	Drawing Cites
A method of providing a service and generating, at the location of a user chosen and designated remote printer, a permanent record of said service, wherein,	[0052]	Fig. 5B, remote printer 15
before generating the permanent record, data necessary to provide said service and data necessary to provide said permanent record are processed by at least one remote server operated by a server provider	[0052], data needed to provide the service (ticket) and data necessary to provide permanent record (printed ticket)	Fig. 3B, server 60
said method comprising the steps of:		

¹ For ease of reference, citation will be to paragraph numbers ([xxxx]) as they appear in the published application of this case—U.S. Pat. Pub. 2003/0115250 A1.

Claim Element	Specification Cites	Drawing Cites
receiving over a data communications network at a remote service provider receiving center, from a user operated communications device, a request for the service and	[0052]	Fig. 3B schematically shows a communications network including a remote service provider receiving center 12; the user operated communications device is illustrated as a telephone 14 and network 20
said data necessary to provide the service including user provided data identifying and specifying said user chosen remote printer and data regarding how to address and access said remote printer over a data communications network;	[0052]	
said receiving center comprising at least one service provider operated remote server;	[0052]	Server is illustrated, e.g., Fig. 3B, 60, processing of data schematically shown, e.g., in Fig. 5B
said data necessary to provide the service being processed to generate data required for the service;	[0052]	Server is illustrated, e.g., Fig. 3B, 60, processing of data schematically shown, e.g., in Fig. 5b
processing on said service provider operated remote server said data required for the service and other stored data to generate input data for a specific and identified user chosen and designated remote printer;	[0052]	Server is illustrated, e.g., Fig. 3B, 60, processing of data schematically shown, e.g., in Fig. 5B
and transmitting by said service provider over a data communication network to said specific user designated remote printer said input data,	[0052]-[0055]	See, e.g., Figs.3B and 5B
said input being rendered by the specific printer as the permanent record of said service.	[0024]	See, e.g., Figs. 3B, 5B and 6

Claim 15

Claim Element	Specification Cites	Drawing Cites
A system for providing a service, generating, at the location of a user chosen and designated remote printer, a permanent record of said service, and, before generating the permanent record, processing, utilizing at least one remote server, data necessary to provide said service and data necessary to provide said permanent record, said system comprising:	An exemplary explanation of a system according to this claim is found in paragraphs [0052]-[0055]. Alternatives that are useful in the claimed systems are described in paragraphs [0056]-[0061].	Figs. 3B and 5B exemplify an embodiment of the claimed system used to print a ticket.
means for receiving at a remote service provider receiving center, from a communications device, a request for the service and said data necessary to provide the service including user provided data identifying and specifying said user chosen and designated remote printer and data regarding how to address and access said remote printer over a data communications network, said receiving center comprising at least one service provider operated remote server; said data necessary to provide the service being processed to generate data required for the service; and,	This means includes the receiving center described in the exemplary embodiment concerning printing of a ticket which is described in paragraphs [0052]-[0055].	The structure of this means includes Receiving/Service server 60 of Fig. 3B.
means for processing on said service provider operated remote server said data required for the service and other stored data to generate	This means includes the receiving center described in the exemplary embodiment concerning printing of a ticket which is described in	The structure of this means includes Receiving/Service server 60 of Fig. 3B.

Claim Element	Specification Cites	Drawing Cites
input data for a specific and identified user chosen and designated remote printer; and	paragraphs [0052]-[0055].	
means for transmitting by said service provider over a data communication network to said specific user designated remote printer said input data, said input being rendered by the specific printer as the permanent record of said service.	This means includes the network schematically illustrated in Fig. 3B and described in paragraphs [0052]-[0055].	The structure of this means includes networks 20 and/or 25 of Fig. 3B which communicate between the Receiving/Service server 60 and remote printer 15.

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- Claims 1-10, 13-18, 21-24 under 35 U.S.C. § 103(a) as unpatentable over US-A-2002/0078160 (“Kemp”) in view of US-A-2002/0113994 (“Smith”); and
- Claims 11, 12, 19 and 20 under 35 U.S.C. § 103(a) as unpatentable over Kemp in view of US-A-2002/0100802 (“Sehr”) and further in view of Smith.

7. ARGUMENT

A. Rejection of claims 1-10, 13-18, 21-24 under 35 U.S.C. § 103(a) as unpatentable over Kemp and Smith

1. Separate argument for claim 1

A claim is obvious only when the subject matter of the claim as a whole would have been obvious to a person of ordinary skill in the art. 35 U.S.C. § 103(a). For the reasons that

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follow, the Office's rejection does not properly account for the requirement that the claimed method uses a user chosen and designated printer.

Claim 1 requires the use of a "user chosen and designated remote printer" to provide a permanent record of the service. Thus, the method of claim 1 involves two types of data:

- (1) data necessary to *provide the service* being processed (for example, information to fulfill the service request such as an event ticket, coupon, image, or a compound document); and
- (2) data required for the service (which is used to generate input data for the specific *printer designated by the user* to render the *permanent record of the service*);

The first data type is handled at the service provider where the service is completed. The second data type is utilized by the service provider to provide a permanent record of the service (like a receipt), *which is printed at a printer of the user's choosing*.

Appellants submit that Kemp does not disclose, teach, or suggest the use of a user chosen and designated printer and, thus, the second data type. Rather, Kemp discloses a remote printing service where a user sends a file to the remote printing service provider over a data network. It is the service provider who chooses the printer, not the user. As seen in paragraph [0057] and illustrated in Fig. 6B of Kemp, the user selects "Remote Printing To Service Providers" and the selected provider in turn prints the file at its print shop for later pick-up by or delivery to the user. See paragraph [0056].

Kemp describes how a pop-up window appears to the user displaying certain information regarding the print job, and the user is requested to confirm the print request.

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This is a different method than what is claimed by Appellants because the information provided by the user relates to the service (first data type) not to the designation of a printer to be used to render the permanent record of the service (second data type). Furthermore, Kemp makes no mention of a permanent record of this printing service that is transmitted to a remote printer and that is chosen by the user. The user responds to the pop-up window for the purpose of causing the service to be effected or cancelled, but does not do so to make a permanent record of the service, especially one that is printed at a printer designated by the user.

Indeed Kemp is quite clear that in that invention the “print job is not being submitted directly to a specific printer, but rather is being submitted directly to a server in a service provider 2, whereby an operator at service provider 2 selects which printer in the print shop is to process the print job.” *Id.*, paragraph [0068]. See also, paragraph [0073], (“service provider server 20 stores the print data and waits for an operator to select a printer for processing the job.”). Accordingly, Kemp actually teaches away from the subject matter of claim1 and thus cannot render it obvious because there is no teaching or suggestion for the user to control the designation of the printer to render the permanent record of the service. Instead, Kemp is explicit that the service provider, not the user designates the remote printer used to generate the permanent record.

The Office then turns to Smith to make up this deficiency, asserting that it is well-known in the art and would have been an obvious modification of Kemp to permit the user to control the selection of the specific remote printer. However, Smith fails to remedy the fundamental deficiency in Kemp.

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Smith only describes a portable device, *e.g.*, a PDA, that prints by transferring print information to a remote printer via the web. See, *e.g.*, paragraph [0033]. In the method of claim 1 on appeal, a user chosen and designated printer is used that requires the transmission of two types of data – the first to request the required service from the remote service provider and the second to provide instructions to the service provider regarding where the permanent record of the transaction should be printed (two parties involved and two separate types of data). Smith only describes one party (the user), who sends print information (one type of data) over the web to the user's own printer, not to a service provider as in Kemp. See paragraph [0021] of Smith that describes the “user's own equipment **113**.” As seen in Fig. 1 of Smith, the printer 115 is part of the user's equipment 113. Thus, Smith does not contemplate a device that transmits data regarding where the user wants the permanent record of the transaction rendered to a service provider, as in Kemp, who in turns carries out these requested instructions. Kemp and Smith are simply not combinable in the manner needed to arrive at the subject matter of claim 1.

Appellants submit that it is error on the Office's part to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 USPQ.2d 1780 (Fed. Cir. 1992). The Office cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ.2d 1596, 1600 (Fed. Cir. 1988). Kemp itself requires the service provider, not the user, to select the printer and, thus, is silent with respect to the printing of the second type of data, namely, printing of a permanent record of the transaction at a user designated remote printer.

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The Office has not pointed to any reason why Kemp alone or in combination with Smith would suggest printing of a permanent record of the transaction at a user designated remote printer. The only user interaction involves the initial selection of the service itself and whether the user wishes to proceed once the cost and properties are determined based on that selection, not a remote printer. Nothing in the disclosures of Kemp or Smith, which both only show the user in control of the destination of the initial service, would have suggested to have the user control the printing of a permanent record of the service.

Missing from the Office's analysis is the understanding that in Kemp, the user can only select the service provider, not the printer located at the service provider that will be used to print the submitted data. There is no disclosure in Kemp that enables a user to select a specific printer and since Kemp explicitly states that the service provider selects the printer, not the user, Kemp teaches away from the proposed combination.

Appellants submit that the Office erred by engaging in the impermissible hindsight reconstruction of Appellants' claimed method and is not applying the correct test for obviousness. In view of the foregoing arguments, Appellants submit that the Office has failed to establish a proper *prima facie* obviousness rejection. Reversal of the rejection is requested.

2. *Separate argument of claim 15*

The system of claim 15 must generate at the location of a user chosen and designated remote printer a permanent record of a service. For the reasons set forth above in regard to

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claim 1, the combined disclosures of Kemp and Smith do not render the subject matter of claim 15 obvious.

3. *Dependent claims 2-10, 13, 14, 16-18 and 21-24 are not separately argued*

Solely for the purpose of this appeal, these dependent claims are not separately argued and are patentable for the reasons set forth above in regard to independent claims 1 and 15.

B. *Rejection of claims 11, 12, 19 and 20 under 35 U.S.C. § 103(a) as unpatentable over Kemp in view Sehr and further in view of Smith*

Appellants traverse the rejection because Sehr does not remedy the deficiency in the combination of Kemp and Smith.

Claims 11 and 12 are dependent on claim 1 and recite the method wherein the requested service is an event ticket or coupon, respectively. Likewise, claims 19 and 20 are dependent of claim 15 and recite the system wherein the requested service is an event ticket or coupon, respectively.

The Office relies on Sehr because it discloses providing an event ticket service or redeemable points in a card, accordingly to supply the event ticket or coupon missing from Kemp. However, Sehr is also silent with respect to the use of a user chosen and designated remote printer and printing of the second type of data, namely, printing of a permanent record of the transaction at a user designated remote printer. Accordingly, the combination of the Sehr, Kemp, and Smith is improper.

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In view of the foregoing arguments, Appellants submit that the Office has failed to establish a proper *prima facie* obviousness rejection. Reversal of the rejection is requested.

Conclusions

Appellants request: that all rejections be reversed.

Date: January 31, 2008

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CLAIMS APPENDIX

1. A method of providing a service and generating, at the location of a user chosen and designated remote printer, a permanent record of said service, wherein, before generating the permanent record, data necessary to provide said service and data necessary to provide said permanent record are processed by at least one remote server operated by a server provider, said method comprising the steps of:
 - receiving over a data communications network at a remote service provider receiving center, from a user operated communications device, a request for the service and said data necessary to provide the service including user provided data identifying and specifying said user chosen remote printer and data regarding how to address and access said remote printer over a data communications network, said receiving center comprising at least one service provider operated remote server; said data necessary to provide the service being processed to generate data required for the service;
 - processing on said service provider operated remote server said data required for the service and other stored data to generate input data for a specific and identified user chosen and designated remote printer; and
 - transmitting by said service provider over a data communication network to said specific user designated remote printer said input data, said input being rendered by the specific printer as the permanent record of said service.
2. The method of claim 1 wherein the receiving center comprises a receiving server.

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3. The method of claim 2 wherein step (B) further comprises the steps of:
providing said data required for the service to a printing server; and generating the input data for a specific printer at the printing server.
4. The method of claim 1 wherein step (B) further comprises:
completing a transaction at a transaction server, said transaction depending on the requested service, said transaction server being one of said remote servers.
5. The method of claim 2 wherein step (B) further comprises:
completing a transaction at a transaction server, said transaction depending on the requested service, said transaction server being one of said remote servers.
6. The method of claim 1 further comprising the step of sending, after step (B) a message confirming that the request for service has been fulfilled.
7. The method of claim 2 further comprising the step of: sending, after step (B) a message confirming that the request for service has been fulfilled.
8. The method of claim 1 wherein step (B) further comprises:
processing the data for the service and other data to generate input data to produce the optimal quality print for a specific printer.
9. The method of claim 2 wherein the receiving server is a printing server.
10. The method of claim 2 wherein the receiving server is a service server.
11. The method of claim 1 wherein the requested service is an event ticket.
12. The method of claim 1 wherein the requested service is a coupon.
13. The method of claim 1 wherein the requested service is an image.

14. The method of claim 1 wherein the requested service is a compound document.
15. A system for providing a service, generating, at the location of a user chosen and designated remote printer, a permanent record of said service, and, before generating the permanent record, processing, utilizing at least one remote server, data necessary to provide said service and data necessary to provide said permanent record, said system comprising:
 - means for receiving at a remote service provider receiving center, from a communications device, a request for the service and said data necessary to provide the service including user provided data identifying and specifying said user chosen and designated remote printer and data regarding how to address and access said remote printer over a data communications network, said receiving center comprising at least one service provider operated remote server; said data necessary to provide the service being processed to generate data required for the service; and,
 - means for processing on said service provider operated remote server said data required for the service and other stored data to generate input data for a specific and identified user chosen and designated remote printer; and,
 - means for transmitting by said service provider over a data communication network to said specific user designated remote printer said input data, said input being rendered by the specific printer as the permanent record of said service.
16. The system of claim 15 further comprising: means for completing a transaction at a transaction server, said transaction depending on the requested service, said transaction server being one of said remote servers.
17. The system of claim 15 further comprising: means for sending, after processing the data required for the service, a message confirming that the request for service has been fulfilled.
18. The system of claim 15 further comprising: means for processing the data for the service and other data to generate input data to produce the optimal quality print for a specific printer.

19. The system of claim 15 wherein the requested service is an event ticket.
20. The system of claim 15 wherein the requested service is a coupon.
21. The system of claim 15 wherein the requested service is an image.
22. The system of claim 15 where in the requested service is a compound document.
23. The system of claim 15 wherein the receiving center comprises a receiving server.
24. The system of claim 15 further comprising: means for providing said data required for the service to a printing server; and means for generating the input data for a specific printer at the printing server.

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EVIDENCE APPENDIX

None

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RELATED PROCEEDINGS APPENDIX

None